

121689-1

Application No. 10/635,065
Amendment dated: August 21, 2006
Reply to Office Action of June 21, 2006

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REMARKS/ARGUMENTS

AUG 21 2006

In the Office Action dated June 21, 2006, the Examiner again rejected claims 1 – 8. Claims 9 – 22 were previously withdrawn. The Applicant urges the Examiner to re-consider claims 1 – 8 in view of the following arguments. No new matter has been added.

Claim Rejections under 35 USC 103 (a)

The Examiner rejected claims 1 – 2 and 6 – 8 under 35 U.S.C. 103(a) as being unpatentable over Bramhall (US Pat. 4,323,533) in view of Mittman (US Pat. 3,176,058). Further, claims 3-5 were rejected under 35 U.S.C. 103(a) as being rendered obvious by Bramhall in view of Mittman and further in view of Pricone (US Pat. 4,486,363). The Applicant courteously traverses these rejections.

It is the Applicant's position that the Examiner has failed to establish a *prima facie* case of obviousness because all of the claim limitations must be taught or suggested by the combination of the Bramhall and the Mittman references. It is the Applicant's position that no combination of the Bramhall and Mittman references can be read to disclose or suggest the instant invention.

In the Office Action dated June 21, 2006, the Examiner appears to have taken the position that although a combination of the Bramhall and Mittman references does not expressly name each and every element of the Applicant's claimed invention, the combination of the Bramhall and Mittman references suggests all of the limitations of the Applicant's claimed invention. The Applicant urges that a combination of the Bramhall and Mittman references actually teaches away from the claimed invention and therefore cannot logically suggest the claimed invention.

The Applicant's claim 1 recites: (a) heating a resin and forming a flowable melt; (b) directing a planar film of the flowable melt to a first nip; (c) embossing a first side of

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the flowable melt and cooling a second side of the flowable melt to form an embossed film; and (d) cooling the embossed film.

The Applicant stresses that the embossing step is carried out on the flowable melt itself. The Examiner asserts that Bramhall teaches each of elements (a), (b) and (d) of Applicant's claim 1, but acknowledges that Bramhall does not disclose element (c), "embossing a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film". The Examiner invokes the Mittman reference to provide or suggest the missing element.

In the Office Action Response dated April 10, 2006 the Applicant demonstrated that the Mittman reference neither discloses nor suggests element (c) of the Applicant's claim 1, i.e., "embossing a first side of the flowable melt and cooling a second side of the flowable melt to form an embossed film". For example, item 12 shown in Figures 1 and 2 of Mittman is described as a "film" not a "flowable melt". Mittman at column 2, lines 22-38 describes the embossing of a film or a sheet, not a "flowable melt". Mittman at column 4, lines 20-34 describes the process implicit in Figure 1 as operating on a "film" 12. At column 4 lines 60-74 Mittman describes the embossing of an "unsupported film" referred to as item 12. Finally, Mittman's claims are directed to "embossing a sheet of relatively soft plastic...." At no point does the Mittman reference disclose or suggest a process for embossing a "flowable melt" from which an embossed film is ultimately formed. The distinction between the "flowable melt" in the instant claim and "film" in the Mittman reference is further evident from paragraph [0021] of the Applicant's Specification which states that "More preferably, the direction of the melt as it is dropped into the first nip is biased toward the embossing tool such that the film-shaped melt first contacts the embossing roll". Thus it is the film-shaped melt that is being embossed, not a film, as disclosed by Mittman.

Those skilled in the art will appreciate the difference between an embossing process which operates upon an unsupported plastic film or sheet (as in Mittman) and the

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embossing process of the instant invention which forms a flowable melt, and further a film-shaped melt, and embosses a first side of the film-shaped melt and cooling a second side of the film-shaped melt to form an embossed film.

The following example is illustrative. A flowable melt may be formed from a plastic material initially in powder form by subjecting the plastic material in powder form to extrusion to provide a flowable melt and then a film-shaped melt which may be converted directly from the melt into an embossed film using the process of the instant invention. The hypothetical process suggested by a combination of the Bramhall and Mittman references would first require the preparation of a film or sheet from the plastic material initially in powder form, and thereafter embossing the film or sheet in a separate step.

The combination of the Bramhall and Mittman references actually teaches away from the Applicant's claimed invention. At most, a combination of the Bramhall and Mittman references suggests a conventional film forming process in which a polymer melt is first formed into a film, and subsequently the film is embossed. A combination of the Bramhall and Mittman references does not suggest the process of the Applicant's claimed invention because the combination of these references teaches or suggests an entirely different process. The Examiner appears to posit that because Bramhall teaches that flowable melts may be formed into films which are no longer flowable melts, and Mittman teaches that films which are not flowable melts may be embossed, that the combination of Bramhall and Mittman suggests that flowable melts may be embossed as flowable melts and subsequently cooled to provide embossed films. Again, it is the Applicant's position that a combination of the Bramhall and Mittman references suggests no more than a conventional film forming process in which a film is prepared from a flowable melt, and subsequently, the film is embossed. It is the Applicant's position that no fair reading of the Bramhall and Mittman references suggests the key inventive element of the Applicant's claimed invention, the embossing of the flowable melt itself rather than embossing a film formed from the flowable melt.

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The Examiner thus fails to establish a prima facie case of obviousness, and thus the rejection of any of the claims of the instant invention under 35 U.S.C. 103(a) as being unpatentable over Bramhall in view of Mittman is unwarranted. With respect to the rejection of claims 3-5 under 35 U.S.C. 103(a), the Applicant urges that claim 1 and claims dependent thereupon recite subject matter patentable over the cited references.

In view of the above, the Applicant requests that the Examiner kindly consider the Applicant's arguments and reasoning contained herein, and withdraw the rejection of claims 1-8. Should the need arise, the Examiner is respectfully requested to contact the Applicant's representative at the telephone number listed below.

Respectfully submitted,



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